REMARKS

Claims 1-34 are pending. Claims 1, 12 and 23 are independent. Claims 1, 2, 4-6, 8, 12-17, 23, 24, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Clanton in further view of Boylan.

With regard to Claim 1, the Examiner states that although Clanton does not specifically teach the localized content targeted to a particular locality; however, Boylan does teach a localized content targeted to a particular locality. The Examiner argues that it would have been obvious to one of ordinary skill in the art to modify the Clanton local merchant advertisements with the Boylan localized content targeted to a particular locality for the purpose of providing a means for tailoring advertisements to specific users "thus increasing the effectiveness of the advertising presenting advertisement that are relevant to a user's location".

However, in determining obviousness, "[t]he claimed invention must be considered as a whole, and the question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Lindemann Maschinenfabrik GMBH v. American Hoist & Derrick, 221 USPQ 481, 488 (Fed. Cir. 1984).

Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under Section 103, teachings of references can be combined only if there is some suggestion or incentive to do so. ACS Hospital Systems,

Inc. v. Montefiore Hospital, 221 USPQ 929, 933 (Fed. Cir. 1984).

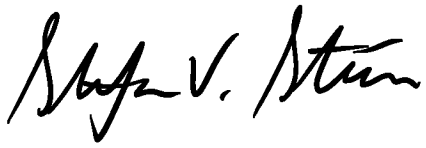
"The critical inquiry is whether 'there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination.'" Fromson v. Advance Offset Plate, Inc., 225 USPQ 26, 31 (Fed. Cir. 1985).

"The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification." In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

Applicant has filed this RCE in lieu of proceeding with his appeal in order to ascertain the basis for the Examiner's contention that the asserted references suggest "increasing the effectiveness of the advertising presenting advertisement that are relevant to a user's location" in the context of Applicant's claimed invention. Respectfully, it is believed that the Examiner's approach to simply claim an "increased effectiveness" to justify a prima facie Section 103 rejection would eviscerate the protections of Section 103 (eliminating synergism and other artificial requirements for patentability) and the protections of the teaching/suggestion/motivation requirements of present day Federal Circuit legal precedent. Hence, the rejections are respectfully traversed and reconsideration is respectfully requested.

The Commissioner is hereby authorized to charge any additional fees which may be required at any time during the prosecution of this application without specific authorization, or credit any overpayment, to Deposit Account No. 50-1667.

Respectfully submitted,



Stefan V. Stein Reg. No. 29,702
Holland & Knight LLP
P.O. Box 1288
Tampa, Florida 33601-1288
Telephone: 813/227-8500
Facsimile: 813/229-0134

4436648_v1